

71470 U.S. PTO
04/03/97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
REQUEST FOR FILE WRAPPER CONTINUING APPLICATION UNDER 37 CFR 1.62
(RULE 62)
For Design or Utility Applications

Page 1 of 4
PATENT
APPLICATION

BOX FWC

The Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Prior Application:

Group Art Unit: 3309

Examiner: TUCKER, G.

Atty Dkt: 225557 / none

new M# / Client Ref.

(Our Deposit Account No. 03-3975

(Our Order No. 40858 / 225557

C# / new M#

Date: April 3, 1997

Sir:

This is a RULE 62 Request for filing from
prior copending parent Application No. 08 /389,399, a
series code ↑ ↑ serial no.

☐ divisional

☒ continuation (**Exr. NOTE:** any election in parent as to species/restriction requirement:

☒ is carried over with traverse) ☐ is not carried over)

☐ continuation-in-part without new Declaration (Rule 53(d)) ☐ without fee

☐ continuation-in-part (with new Declaration attached hereto)

The parent was filed on February 16, 1995, entitled METHOD AND APPARATUS FOR FORMING
A CENTERED BORE FOR THE FEMORAL STEM OF A HIP PROSTHESIS

by the following named inventor(s) who is/are ☐ the same as, ☐ less than all of (see Item 17),

☒ more than (for CIP only), those named in that parent application:

1. Inventor Lanny L. JOHNSON USA
First Middle Initial Family Name Country of Citizenship

Residence (City) (State/Foreign Country)

Post Office Address 2950 E. Mount Hope Road, Okemos, MI 48864

(include Zip Code)

2. Inventor
First Middle Initial Family Name Country of Citizenship

Residence (City) (State/Foreign Country)

Post Office Address

(include Zip Code)

3. Inventor
First Middle Initial Family Name Country of Citizenship

Residence (City) (State/Foreign Country)

Post Office Address

(include Zip Code)

4. Inventor
First Middle Initial Family Name Country of Citizenship

Residence (City) (State/Foreign Country)

Post Office Address

(include Zip Code)

5. Inventor
First Middle Initial Family Name Country of Citizenship

Residence (City) (State/Foreign Country)

Post Office Address

(include Zip Code)

NOTE: FOR ADDITIONAL INVENTORS, check box ☐ and attach sheet (CDC-110A) with same information for each
inventor starting with inventor No. 6 and number new page 1A.

1. **Requirement of Rule 62:** Rule 62 filings are to be used only when the issue fee has not been paid (except as noted below) in the above-identified prior application nor that application abandoned or its proceedings terminated. This Rule 62 filing will be considered by the PTO as an express abandonment of that prior application except when this Rule 62 filing is pursuant to Rule 313(b)(5), i.e., when the issue has been paid in the prior application and a petition filed to abandon that application to permit an IDS to be considered in this Rule 62 application. (Note: 37 CFR 1.53 (Rule 53) may be used for continuations and divisions where the prior application is not to be abandoned.)
2. ☐ The issue fee has been paid in the parent, but this Rule 62 Request follows a Rule 313(b)(5) petition, and per 1138 OG 40 waiver is respectively requested of that part of Rule 62 which prohibits use of the rules to file an FWC after payment of the issue fee.
3. ☐ Priority is claimed under 35 U.S.C. 119/365 based on filing in _____ of:
(country)
- | <u>Application No.</u> | <u>Filing Date</u> | <u>Application No.</u> | <u>Filing Date</u> |
|------------------------|--------------------|------------------------|--------------------|
| (1) _____ | _____ | (4) _____ | _____ |
| (2) _____ | _____ | (5) _____ | _____ |
| (3) _____ | _____ | (6) _____ | _____ |
- a. ☐ _____ (No.) Certified copy/copies attached.
- b. ☐ Certified copy/copies previously filed on _____ in prior
U.S. Application No. _____ / _____, filed on _____
series code ↑ ↑ serial no.
- c. ☐ Certified copy/copies filed during International stage of PCT/ _____ / _____.
- d. ☐ Priority is also claimed from PCT/ _____ / _____ filed _____.
- ☐ The prior application is assigned of record to _____
by Assignment recorded _____ Reel _____ Frame _____
Date _____
- ☐ Attached is an Assignment Cover Sheet.
Please return the recorded Assignment to the undersigned.
- ☒ The power of attorney in the prior application is to Kevin E. Joyce, 20,508

(Name, Reg. No.)
the address of whom is in item 8.
7. ☐ Recognize as associate attorney _____

(Name and Reg. No.; Address as in item 8 unless otherwise indicated)
8. **Address all future communications to Cushman Darby & Cushman Intellectual Property Group of Pillsbury Madison & Sutro LLP, Ninth Floor, East Tower, 1100 New York Avenue, N.W., Washington, D.C. 20005-3918.**
9. ☒ Amend the specification by inserting before the first line (in place of any comparable insert previously requested in any prior application) the sentence: --This is a
☐ continuation-in-part (CIP) ☒ continuation ☐ division
of Application No. 08/389,399, filed on February 16, 1995, which was
series code ↑ ↑ serial no.
abandoned upon the filing hereof _____.
10. ☒ 1 (No.) Verified Statement(s) establishing "small entity" status under Rules 9 and 27
a. ☒ filed in above prior application (and hence applicable hereto)
b. ☐ attached.

11. **Requirement of Rule 62:** It is understood that secrecy under 35 U.S.C. 122 is hereby waived to the extent that if information or access is available to any one of the applications in the file wrapper of a 37 CFR 1.62 application, be it either this application or a prior application in the same file wrapper, the Patent and Trademark Office may provide similar information or access to all the other applications in the same file wrapper.

12. Petition to extend the life of the above prior application to at least the date hereof

NOTE: (One box) ☐ is being concurrently filed in that prior application (Use Form CDC-111).
 (must be) ☐ was previously filed in that prior application (Check length of prior extension).
 (X'd) ☒ is not necessary for copendency (double check before X'ing this box).

13. ☒ Please enter the amendment previously filed on November 22, 1996
 but unentered in the above prior application.

14. ☐ Attached: _____ sheet(s) per set of drawing of Fig(s) _____;
☐ 1 set informal; ☐ formal of size: ☐ A4 ☐ 11"

15. ☒ **PRELIMINARY AMENDMENT to be entered before fee calculation** (Do not make amendments here except cancellation of whole claims or multiple dependencies for purpose of reducing the filing fee per MPEP §§ 506 and 607; do not cancel all claims.):

16. ☐ Attached is a Rule 103(a) Petition to Suspend Action

17. Petition is hereby made requesting deletion as inventor(s) of the following who is/are not inventor(s) of the invention being claimed in this Rule 62 application:

1. _____ 2. _____
 3. _____ 4. _____

18. ☐ This Rule 62 application is a continuation-in-part which discloses and claims additional matter and the amendments in attached Amendment are to be considered an integral part of the CIP ab initio.

a. ☐ New Declaration is attached.

b. ☐ This application is also filed under Rule 53(d) (without a Declaration) and hence filing fee is not enclosed.

FILING FEE

THE FOLLOWING FILING FEE IS BASED ON THE CLAIMS
 EXISTING IN THE PRIOR APPLICATION AS AMENDED AT 13 AND 15 ABOVE

| | see box 10 re: | Large/Small Entity | Fee Code |
|--------------------------------|------------------------------|--------------------|----------------------------|
| 19. Basic filing fee - - - - - | Design Appln. - - | \$320/\$160 | \$ _____ (106/206) |
| 20. Basic filing fee - - - - - | <u>Not</u> Design Appln. - - | \$770/\$385 | \$ <u>385.00</u> (101/201) |

| | | | | | | | | |
|----------------------------|-----------|----------|---|-------------|-------------|---|--------------|-----------|
| 21. Total Effective Claims | <u>15</u> | minus 20 | = | * <u>00</u> | x \$22/\$11 | = | + <u>.00</u> | (108/208) |
| 22. Independent Claims | <u>01</u> | minus 3 | = | * <u>00</u> | x \$80/\$40 | = | + <u>.00</u> | (102/202) |

* If answer is zero or less, enter "0"

23. If any proper (ignore improper) multiple dependent claim is present, - - - - - add \$260/\$130 + 00 (104/204)

24. **TOTAL FILING FEE =** \$ 385.00

25. If "assignment" box 5 above is X'd, - - - - - add recording fee (\$40.00) + _____ (581)

26. If "petition" box 16 above is X'd, - - - - - add petition fee (\$130.00) + _____ (122)

27. **FEE ATTACHED =** \$ 385.00
 (carry forward to line 36)

28. ☐ Preliminary Amendment attached (to be entered after assigning Appln. No.).
 (Do NOT X box 28 or 29 for CIP Amendment. See box 18)
29. ☐ The following PRELIMINARY AMENDMENT is to be entered after assigning Appln. No.:

30. ☐ ATTACHED:

31. **ADDITIONAL FEE CALCULATION FOR
PRELIMINARY AMENDMENT
PER BOXES 28/29**

| | Claims remaining after amendment | Highest number previously paid for | Present Extra | | Additional Fee | |
|-----|---|---|----------------------------------|--|-------------------------|-----------------|
| | | | | <u>Large/Small Entity</u> | | <u>Fee Code</u> |
| 32. | Total Effective Claims | <u>12</u> | minus ** <u>24</u> = * <u>0</u> | x \$22/\$11 = | \$ <u>.00</u> | (10310) |
| 33. | Independent Claims | <u>03</u> | minus *** <u>03</u> = * <u>0</u> | x \$80/\$40 = | + <u>.00</u> | (10210) |
| 34. | If amendment enters proper multiple dependent claim(s) into this application for the first time, ----- add \$260/130 (per application) | | | | + <u>.00</u> | (10410) |
| 35. | | | | ADDITIONAL FEE | \$ <u>.00</u> | |
| 36. | | | | <u>plus</u> FEE from item 27 on page 3 | + <u>385.00</u> | |
| 37. | | | | <u>TOTAL FEE ATTACHED</u> | \$ <u>385.00</u> | |

38.*If the entry in the first space is less than entry in the middle space, the "Present Extra" result is "0".

39.**If the "Highest number previously paid for" (see item 21 above) is less than 20, write "20" in this space.

40.***If the "Highest number previously paid for" (see item 22 above) is less than 3, write "3" in this space.

41. **CHARGE STATEMENT:** The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficient fee only) now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order Nos. shown in the heading hereof for which purpose a duplicate copy of this sheet is attached.
This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal form is filed.

**Cushman Darby & Cushman
Intellectual Property Group of
Pillsbury Madison & Sutro LLP**

1100 New York Avenue, N.W.
Ninth Floor, East Tower
Washington, D.C. 20005-3918
Tel: (202) 861-3000
Atty/Sec: KEJ:jl

By Atty: Kevin E. Joyce

Reg. No. 20,508

Sig: 

Fax: (202) 822-0944

Tel.: (202) 861- 3050

NOTE: No: 1: File this Request in duplicate with 2 postcard receipts (CDC-103) & attachments.

NOTE: No: 2: Is extension in parent necessary for copendency? **DOUBLE CHECK** Item 12 above.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of

JOHNSON, Lanny

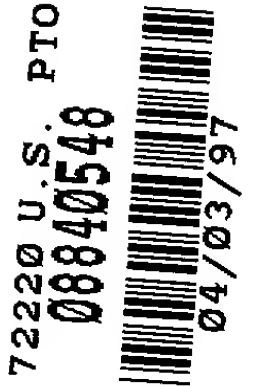
Group Art Unit: 3309

FWC of Appln. No.: 08/389,399

Examiner: Tucker, G.

Filed: February 16, 1995

Title: METHOD AND APPARATUS FOR
FORMING A CENTERED BORE FOR
THE FEMORAL STEM OF A
HIP PROSTHESIS



April 3, 1997

PRELIMINARY AMENDMENT

Assistant Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Prior to the examination of the subject application, please
enter the following amendments:

IN THE CLAIMS:

Amend Claim 1 to read:

1. (Three times amended) An instrument for forming a
centered [bone] bore in a femur in preparation for implantation
of a femoral prosthesis, wherein the femur includes an
intramedullary canal defined by an interior wall of cortical
bone, the instrument comprising:

a handle joined to [the] a proximal end of an elongated rod
sized to be received within said canal; and

[means] fins fixed at a distal end of the rod, and
projecting outwardly in opposing directions from the rod in a

JOHNSON - FWC of Appln. No. 08/389,399

single planar relationship, for engaging the interior wall of the cortical bone when said rod is inserted within the canal so as to center the rod relative to the wall.

Amend Claim 4 to read:

4. (Twice amended) An instrument as set forth in claims [2] 1 or 3, wherein said rod is provided with graduated markings along its length.

REMARKS

The foregoing amendments correct inconsistencies introduced by the November 22, 1996 amendment and further distinguish applicant's invention from the prior art of record for the reasons presented on November 22.

Respectfully submitted,

CUSHMAN DARBY & CUSHMAN
Intellectual Property Group of
Pillsbury Madison & Sutro LLP

By: 

Kevin E. Joyce
Reg. No. 20,058
Tel. (202) 861-3050
Fax (202) 822-0944

KEJ:jl

Ninth Floor
1100 New York Avenue, N.W.
Washington, D.C. 20005-3918
Tel. (202) 861-3000